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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Young-jin Hong

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EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/988,672

Applicant(s)

HONG, YOUNG-JIN

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claims 1-20 were examined in this final office action.

Response to Arguments

Applicant's arguments filed 01 August 2006 have been fully considered but they are not persuasive. The Applicant's arguments rely solely on disputing the taking of Official Notice. The purpose of the acceptance key supplied by the service of the cited prior art and later repeated by the user is to verify user identity. The purpose of a password initially provided by the user and later repeated by the user is to verify user identity. The service provides a convenience to the user by generating the password-less work for the user. Whether the user or the system provides a password is of no consequence to the functionality of the claimed invention. The Examiner has established a prima facie case. Prior art cited in the previous office action (Paper #200604071, Item: U) provides an example of user-created passwords (see page 5).

The Examiner is suggesting the Applicant consider a telephonic interview for further discussion.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1, 2, 5, 6, 8, and 19 are rejected under 35 USC 103(a) as being unpatentable over Chernow (US 4,999,806) in view of Official Notice (regarding old and well-known in the arts, hereinafter referred to as ON1).**

Chernow teaches a telephone ordering system whereby a user can order via the telephone downloadable software. The system implements a call back feature that delivers the order software upon successful reconnection with the user and the user providing a temporary password. Chernow further teaches:

- receiving a temporary password and purchasing conditions from a user through telephone connection: (see below)
- retrieving article information meeting the purchasing conditions received in step (a), after ending the telephone connection: software product to be purchased in retrieved after ending the call (see at least Fig. 1A (g); Fig. 1B (j, k, l).
- setting telephone connection to the user using the user's originator telephone number and confirming the user using the temporary password received in step (a): system calls the user back (see at least Fig. 1B).

- providing the article information retrieved in step (b) and arranging a transaction according to the user selection: delivers the ordered product (see at least Fig. 1B).

Chernow teaches all the above as noted under the 103(a) rejection and teaches a user a) calling an ordering service, b) submitting purchase order information and credit card number to the service (i.e. a number uniquely associated with the user and submitted for one-time use), and c) generating an acceptance key by the system that is transmitted to the user as a temporary password (i.e. one-time code) (see Fig. 1A (e, f)). Chernow, however, does not disclose receiving a temporary password from the user. The Examiner takes the position that it is old and well-known in the arts for users of computer or telephonic technology to create their own password, personal identification number (PIN), or purchase order numbers for later use by the user and the system to verify the user's identity. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chernow to receive a temporary password from the user as taught by ON1. The invention of Chernow generates the temporary password (i.e. acceptance key) however the user could have as easily been queried to provide a temporary password of PIN without destroying the cited reference.

2. **Claim 3 is rejected under 35 USC 103(a) as being unpatentable over Chernow (US 4,999,806) and ON1 (regarding old and well-known in the**

arts), further in view of Official Notice (regarding old and well-known in the arts hereinafter referred to as ON2).

Chernow and ON1 teach all the above as noted under the 103(a) rejection and teach a) the system calling the user back at the telephone number provided by the user (see at least col. 2, lines 51-54), and b) relying upon a set of predetermined telephone numbers from business customers (see at least col. 7, lines 14-43) associated with purchase order numbers, but do not specifically disclose automatically transmitting the telephone number during the telephone connection. The Examiner takes the position that automatic number identification (ANI) is old and well-known in the arts and is used to support a variety of system interactions with callers. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chernow and ON1 to implement ANI as taught by ON2, in order to automatically transmit the originator telephone number during a telephone connection.

- 3. Claim 4 and 7 are rejected under 35 USC 103(a) as being unpatentable over Chernow (US 4,999,806) and ON1 (regarding old and well-known in the arts), as applied to claims 2 and 6, further in view of Bernard (US 5,918,213).**

Chernow and ON1 teach all the above as noted under the 103(a) rejection but do not disclose text to speech. Bernard teaches a system and method of ordering products using a voice response unit to convert speech-to-text and text-to-

speech (see at least Fig. 1 (100); col. 1, line 14 through col. 6, line 53). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chernow and ON1 to implement a voice response system for callers as taught by Bernard, in order to provide text-to-speech conversion for traditional telephone shopping.

4. Claims 9, 12, and 20 are rejected under 35 USC 103(a) as being unpatentable over Chernow (US 4,999,806) in view of ON1 (regarding old and well-known in the arts), further in view of Chen (US 5,978,775).

Chernow teaches a telephone ordering system whereby a user can order via the telephone downloadable software. The system implements a call back feature that delivers the order software upon successful reconnection with the user and the user providing a temporary password. Chernow further teaches:

- receiving a temporary password and purchasing conditions from a user through telephone connection: (see below)
- retrieving article information meeting the purchasing conditions received in step (a), after ending the telephone connection: software product to be purchased in retrieved after ending the call (see at least Fig. 1A (g); Fig. 1B (j, k, l).
- setting telephone connection to the user using the user's originator telephone number and confirming the user using the temporary password received in step (a): system calls the user back (see at least Fig. 1B).

- providing the article information retrieved in step (b) and arranging a transaction according to the user selection: delivers the ordered product (see at least Fig. 1B).

Chernow teaches all the above as noted under the 103(a) rejection and teaches a user a) calling an ordering service, b) submitting purchase order information and credit card number to the service (i.e. a number uniquely associated with the user and submitted for one-time use), and c) generating an acceptance key by the system that is transmitted to the user as a temporary password (i.e. one-time code) (see Fig. 1A (e, f)). Chernow, however, does not disclose receiving a temporary password from the user. The Examiner takes the position that it is old and well-known in the arts for users of computer or telephonic technology to create their own password, personal identification number (PIN), or purchase order numbers for later use by the user and the system to verify the user's identity. The invention of Chernow generates the temporary password (i.e. acceptance key) however the user could have as easily been queried to provide a temporary password or PIN without destroying the cited reference. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chernow to receive a temporary password from the user as taught by ON1.

Chernow and ON1 teach all the above as noted under the 103(a) rejection but do not disclose billing a purchase charge as a telephone charge. Chen teaches a system and method that allows a purchase charge to be billed to the user's

telephone bill (see at least abstract; col. Fig. 1; col. 1 through 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chernow and ON1, in order to provide a customer billing convenience.

- 5. Claims 10, 11, and 13-18 are rejected under 35 USC 103(a) as being unpatentable over Chernow (US 4,999,806), ON1 (regarding old and well-known in the arts), and Chen (US 5,978,775), as applied to claim 9, further in view of Bernard (US 5,918,213).**

Chernow, ON1, Chen teach all the above as noted under the 103(a) rejection but do not disclose text-to-speech. Bernard teaches a system and method of ordering products using a voice response unit to convert speech-to-text and text-to-speech (see at least Fig. 1 (100); col. 1, line 14 through col. 6, line 53).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Chernow, ON1, and Chen to implement a voice response system for callers as taught by Bernard, in order to provide text-to-speech conversion for traditional telephone shopping.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is positioned above the printed name and title.

Robert M. Pond
Primary Examiner
December 20, 2006